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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,628	06/26/2001	Narinobu Kagami	209081US0PCT	4073

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EXAMINER

NGUYEN, CAM N

ART UNIT PAPER NUMBER

1754

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/868,628

**Applicant(s)**

KAGAMI ET AL.

**Examiner**

Cam N. Nguyen

**Art Unit**

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on May 06, 2005 (an amendment/response).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, & 35-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### **Response to Amendment**

1. Applicants' amendment and remarks, filed May 06, 2005, has been made of record and entered. Claims 5, 9-34, & 39-59 were previously canceled.

Claims 1-4, 6-8, & 35-38 are currently pending in the application.

### **Claim Rejections - 35 USC § 102(b)/103**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-8, & 35-38 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yanik et al., "hereinafter Yanik", (US Pat. 4,080,286).

Yanik discloses a catalyst substantially free of phosphates and consisting essentially of a hydrogenating metal selected from Group VI-B and a hydrogenating metal selected from Group VIII, both hydrogenating metals being in a sulfided form,

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supported on a non-zeolitic refractory oxide carrier and promoted with from about 1 to about 10 weight percent of a Group IV-B metal by the addition of the Group IV metal to said carrier after calcination of said carrier; the improvement which comprises in the preparation of said catalyst the step of adding the titanium to said carrier by contacting said carrier with an aqueous solution of a titanium salt (see col. 6, claim 1, ln 9-21).

Yanik further discloses that the carrier is contacted with the aqueous solution of a titanium salt simultaneously with compositing said Group VI and Group VIII hydrogenating metals with said carrier (see col. 6, claim 9). The non-zeolitic refractory oxide carrier is selected from a group including alumina (see col. 6, claim 10). The heating temperature is 121°C for drying and 538°C for calcining (see col. 4, Example 1). Molybdenum and Nickel are being exemplified for Group VI and Group VIII hydrogenating metals (see col. 4, Example 1).

Regarding claim 1, applicants claim a "heating temperature of being not higher than 300°C". The phrase "heating temperature" in the claim is taken to mean the final temperature or calcination temperature. If in fact, applicants means the drying temperature required being not higher than 300°C then the claim is met by the teaching of the Yanik reference because Yanik teaches a drying temperature of 121°C. If in fact, applicants means the calcination temperature required being not higher than 300°C then it would have been *prima facie obvious* to one of ordinary skill in the art at the time the invention was made to have optimized such heating temperature in the process of Yanik in view of In re Boesch.

It is considered the claimed heating temperature is process limitations. While this limitation is not disregarded, it has no bearing on the patentability of the claimed catalyst because it has been held that the product and its method of production are separately determined. While the catalyst disclosed is not made by the same process, the catalyst made is the same as applicants' claimed catalyst. See In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985); In re Brown, 173 USPQ 688, 688 (CCPA 1977); In re Fessman, 180 USPQ 324, 326 (CCPA 1977). See also MPEP 2113.

Regarding claim 2, the claim is met by the teaching of the reference because Yanik teaches titanium compound (see above).

Regarding claims 3 & 4, it is considered the specific titanium compound being claimed is a process limitation, and it has no bearing on the patentability of the claimed catalyst. See In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985); In re Brown, 173 USPQ 688, 688 (CCPA 1977); In re Fessman, 180 USPQ 324, 326 (CCPA 1977). See also MPEP 2113.

Regarding claims 6, 35, & 36, the claimed titanium range is met by the teaching of the reference since the disclosed range fall within the claimed range (see above).

Regarding claims 7 & 37, Mo and Ni are disclosed by the reference, thus meets the claim (see above).

Regarding claims 8 & 38, since Yanik teaches that the catalyst contains phosphates in the amount of less than about 0.1% as contamination (see Yanik at col. 1, ln 45-50), thus provides for the catalyst carries phosphorus, thus meets the claim.

**Response to Applicants' Arguments**

4. Applicants' amendment/response filed on May 06, 2005 has been fully reconsidered, but not deemed persuasive in view of the new ground of rejection above and the following reasons.

Applicants' urging on the intended use of the claimed catalyst is noted, but not found persuasive because the instant claims are drawn to a catalyst and not a process of use. It is considered the claimed catalyst does not depend on the intended use for completeness, but instead the limitations of the catalyst in the claim itself are able to stand alone. [It is well settled that terms merely setting forth intended use for, or a properly inherent in, an otherwise old composition do not differentiate the claimed composition from those disclosed in the prior art]. See *In re Pearson*, 181 USPQ 641. Also, [it is contrary to spirit and patent laws that patents be granted for old compositions of matter based on new uses of compositions where uses consists merely in employment of compositions; patentee is entitled to every use of which invention is susceptible, whether such use be known or unknown to him]. See *In re Thrau*, 57 USPQ 324.

Claims 3-4 & 35-38 were previously indicated allowable, they are now rejected in view of the case laws cited in the new ground of rejection above.

**Conclusion**

5. Claims 1-4, 6-8, & 35-38 are pending in the application. Claims 1-4, 6-8, & 35-38 are rejected. No claims are allowed.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Primary Examiner Cam N Nguyen, whose telephone number is 571-272-1357. The examiner can normally be reached on M, W, R, & F, 8:45 AM - 5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nguyen/cnn *CNN*  
August 06, 2005

*Cam Nguyen*  
CAM N. NGUYEN  
PRIMARY EXAMINER  
*AV-1754*